

REMARKS

I. **Status of the Claims**

Claims 1, 7-13, 15-18, 20-23, 26-27, 33-39, 41-44, 46-56, 59, 83-85, 115 and 119-120 are presently pending in the application. Without prejudice or disclaimer, claim 115 is amended. Support for the amendment can be found in the original claims. See e.g., claims 14 and 25. Accordingly, there is no written description issue raised by this amendment.

II. **Interview Summary**

Applicants' representatives conducted a telephonic interview with Examiner Rogers on April 8, 2011. No agreement was reached on the allowability of the claims. The Examiner maintains that the tests data provided in both Declarations is not enough to overcome the obviousness rejection on record. Applicants contend that the Examiner has not given the comparative results in the Declarations their due consideration with respect to nonobviousness. Accordingly, Applicants agree with the Interview Summary dated April 11, 2011, in that the case appears to be at a clear impasse and no agreement with respect to patentability of the claims could be made at this stage of the prosecution.

III. **Rejections under 35 U.S.C. § 103**

A. **Arnaud**

The Examiner maintains the rejection of claims 1, 7-13, 15-18, 20-23, 26-27, 33-39, 41-44, 46-56, 59, 83-85, 115 and 119-120 under 35 U.S.C. § 103(a) as allegedly

being "unpatentable over Arnaud" for the reasons of record. Office Action at 2. Moreover, the Examiner states that "[t]he declaration under 37 CFR 1.132 filed 10/05/2009¹ is insufficient to overcome the rejection of claims 1, 7-13, 15-18, 20-23, 26-27, 33-39, 41-44, 46-56, 83-85, 115 and 119-120 based upon 35 U.S.C. 103(a) as being unpatentable over Arnaud" *Id.* Applicants traverse the rejection for the reasons of record and the reasons provided below.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. § 2142. In *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (2007), the Supreme Court confirmed that the "framework for applying the statutory language of §103" was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) secondary considerations. 148 U.S.P.Q. at 467. "Such evidence . . . may include evidence of . . . unexpected results." M.P.E.P. § 2141. The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. See *Graham*, 148 U.S.P.Q. 467; see also *KSR*, 82 U.S.P.Q. 2d at 1388. "The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." *Id.* Moreover, "[a] combination of known elements would have been *prima facie* obvious if an ordinarily skilled artisan

¹ The Examiner confirmed that he had reviewed both the Declaration filed on October 2, 2009, ("First Declaration") and the Declaration filed on December 1, 2010 ("Second Declaration").

would have recognized an apparent reason to combine those elements and would have known how to do so." Examination Guidelines Update: Developments in the Obviousness Inquiry After *KSR v. Teleflex*, 75, Fed. Reg. 53,643, 53,695 (Sept. 1, 2010) (citing *Ecolab, Inc. v. FMC Corp.*, 569 F.3d 1335 (Fed. Cir. 2009)).

Arnaud would not have provided any reason to one of ordinary skill in the art, at the time of invention, to select the specific combination of at least one high viscosity phenylsilicone oil chosen from the oils of formula (A), at least one low viscosity phenylsilicone oil having a viscosity of less than 500 cst, and at least one non-volatile ester oil, with a molecular mass greater than 500 g/mol, chosen from pentaerythrityl tetrapelargonate, diisostearyl malate, tridecyl trimellitate, triisocetyl citrate, pentaerythrityl tetraisononanoate, glyceryl triiso-stearate, glyceryl 2-tridecyl tetradecanoate, and pentaerythrityl tetraisostearate, as presently claimed. The Examiner's rejection is based on his assumption that one can pick and choose individual components disclosed in Arnaud to create compositions which will exhibit properties similar to those of the claimed composition. However, the Examiner has failed to articulate findings of fact that support this rationale. Thus, Applicants maintain that the Examiner has not established a *prima facie* case of obviousness.

Statement of unexpected results

The Examiner notes that "the declaration does not actually state that the results presented are unexpected, instead the examples are said to demonstrate unpredictability in the art based upon the differences in the exemplified compositions."

Office Action at 3. Applicants disagree with the Examiners attempt to fabricate a semantic distinction where none exists.

In the previous response, Applicants had, in fact, explicitly stated that the results were both unexpected and unpredictable. See Response of December 1, 2010, p. 18 ("[T]he Second Declaration clearly shows the unexpected/unpredictable results attributable to the claimed composition reciting specific non-volatile ester oils"); p. 19 ("These results are unexpected in view of Arnaud, and show unpredictability in the art."). These statements were supported by the factual evidence presented in the Declaration. See e.g., Declaration filed December 1, 2010, paragraph 20 ("The observed differences in hardness and cosmetic properties demonstrate unpredictability in the art based upon the differences in the above compositions."). Furthermore, there is no requirement for a Declarant to make a statement that the results are "unexpected."

"Predictability as discussed in KSR encompasses the expectation that prior art elements are capable of being combined, as well as the expectation that the combination would have worked for its intended purpose." Examination Guidelines Update: Developments in the Obviousness Inquiry After *KSR v. Teleflex*, 75, Fed. Reg. 53,643, 53,695 (Sept. 1, 2010) (citing *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314 (Fed. Cir. 2009)). The evidence presented in both Declarations clearly demonstrates that this is not the case for the presently claimed composition.

Evaluation of properties of the compositions

The Examiner alleges that "finding the optimum type of oils in order to achieve a non greasy and hard lipstick is not considered unpredictable since a relatively hard and

non-greasy lipstick would be a desirable property for such a cosmetic and this property would be adjusted by known selection processes for the various constituent ingredients of that lipstick." Office Action at 3. Applicants disagree.

As an initial matter, "[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." M.P.E.P. § 2144.05(l)(b).

Arnaud provides a long list of optional oils and esters. See Arnaud col. 3, line 25 - col. 4, line 41 and col. 5, line 21, - col. 6, line 13. In this broad disclosure, Arnaud makes no distinction whatsoever between non-volatile ester oils with a molecular mass greater than 500 g/mol and those with a molecular mass less than 500 g/mol. A person of ordinary skill in the art, reading Arnaud, would not recognize that the molecular mass of the non-volatile ester oil would be a result effective variable.

The M.P.E.P. also states that the "[p]resence of a property not possessed by the prior art is evidence of nonobviousness." M.P.E.P. § 716.02(a)III citing *In re Papesch*, 315 F.2d 381, 137 U.S.P.Q. 43 (CCPA 1963).

By solely considering a "non greasy and hard lipstick" the Examiner has oversimplified the properties tested. The properties of the compositions evaluated in Declaration of 12/01/2010 include: Hardness, Stability of sticks after 24 hours at various temperatures, Homogeneity of deposit on Bioskin, Texture, Level of wear of glossiness, and Level of wear of color. The Examiner does not address any of these other properties. For example, the Examiner has failed to articulate how a person of ordinary skill in the art would apply "known selection processes for the various constituent

ingredients" of a lipstick to adjust, e.g., level of wear of color and level of wear of glossiness. The Examiner provides no basis that such a selection process was known in the art at the time of the relevant time. Furthermore, Arnaud provides no such selection process for such properties. Comparative Compositions 2 and 3, prepared with ester oils recited in Arnaud exhibited a poor level of wear of the glossiness and a poor level of wear of color. See Second Declaration, Table 3.

Evidence commensurate in scope of the claims

The Examiner alleges:

The examples within applicant's declaration are all drawn to a lipstick composition that is much narrower in scope than what is actually claimed. For instance composition 1 contains one specific commercially sourced low viscosity phenyl siloxane with a specific structure and MW whereas the low viscosity oil of claim 1 is any phenylsiloxane which has a viscosity lower than 500 cst. Additionally composition 1 contains one specific commercially sourced high viscosity phenyl siloxane of a specific structure and MW where[as] the high viscosity oil of claim 1 can be any phenylsiloxane which has a viscosity greater than 500 cst.

Office Action at 3. Applicants respectfully disagree.

"Nonobviousness of a genus or claimed range may be supported by data showing unexpected results of a species or narrower range under certain circumstances." M.P.E.P. §716.02(d).I.

The claimed composition comprises, *inter alia*, a combination of a low viscosity phenylsiloxane, a high viscosity phenylsiloxane and at least one of eight different claimed non-volatile ester oils having a molecular mass of more than 500 g/mol. Applicants have directly compared compositions containing non-volatile esters recited in Arnaud having a molecular mass of less than 500 g/mol with compositions containing

the claimed non-volatile esters having a molecular mass of more than 500 g/mol. See Second Declaration, Tables 1-3. The First and Second Declarations, combined, show results with four of the claimed non-volatile ester oils, compared with three non-volatile ester oils outside the scope of the claims. First and Second Declarations, Tables 1-3. Moreover, in the First Declaration, Applicants compared compositions with two different high viscosity phenylsiloxanes and found that they did not differ in cosmetic properties. See First Declaration, Tables 4-6. Applicants submit that the results provided in the specification and both Declarations provide enough examples to allow the skilled artisan to determine a trend in the data and reasonably extend the probative value thereof. See M.P.E.P. §716.02(d)I. Thus the evidence of nonobviousness is commensurate with the scope of the claims.

Accordingly, this rejection over Arnaud is improper and should be withdrawn.

B. Arnaud in view of Willemin

The Examiner maintains the rejection of claims 1, 7-13, 15-18, 20-23, 26-27, 33-39, 41-44, 46-56, 59, 83-85, 115 and 119-120 under 35 U.S.C. § 103(a) as allegedly being "unpatentable over Arnaud" in view of U.S. Patent No. 6,592,855 to Willemin et al. ("Willemin") for the reasons of record. Office Action at 2. Applicants respectfully disagree for the reasons of record and for the reasons presented above.

Furthermore, Willemin does not cure the deficiencies of Arnaud discussed above, i.e., it does not offer any guidance to one of ordinary skill in the art to the presently claimed combination of at least one high viscosity phenylsilicone oil chosen from the oils of formula (A), at least one low viscosity phenylsilicone oil having a viscosity of less than

500 cst, and at least one non-volatile ester oil having a molecular mass of greater than 500 g/mol chosen from the specific non-volatile ester oils recited in the present claims.

Accordingly, Applicants respectfully submit that the rejection should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any outstanding issues, he is respectfully invited to contact Applicants' undersigned counsel at (202) 408-4077.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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